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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/837,044 | 04/18/2001 | Jean-Marie Vau | 81000DAN | 9196 |

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EXAMINER

STRANGE, AARON N

ART UNIT PAPER NUMBER

2153

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 09/837,044 | Applicant(s) VAU, JEAN-MARIE | |
| | Examiner Aaron Strange | Art Unit 2153 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>5112001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
2. The Office recommends that all instances of the term "envelop" be amended to recite "envelope". It appears several times in Page 3, Lines 24-37.
3. Appropriate correction is required.

Claim Objections

4. Claims 6 and 7 are objected to because of the following informalities:
5. With regard to claims 6 and 7, the Office recommends that the term "envelop" located in line 2 of each claim be amended to recite "envelope".
6. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. With regard to claim 1, the limitation "at the defined address stored on the server" in lines 11-12 is unclear. It appears that Applicant may have intended for the claim to

recite "at the defined address on the server", and it has been interpreted as such for the purpose of applying prior art.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1 and 3-7 rejected under 35 U.S.C. 103(a) as being unpatentable over Seattle FilmWorks.

12. The Office would like to inform Applicant that the collection of references from Seattle FilmWorks, while located in a plurality of separate files, have been treated as a single reference. All of the references are parts of the same website, retrieved from the Internet Archive Wayback Machine, dating from 2/08/1999 to 1/15/2000, and relating to the same subject matter. The reference is very much like multiple chapters in a book, and have accordingly been treated a single reference in this Office action. Alternatively, a rejection under 35 USC 103(a) could be made using the combination of references. Since the pages are all part of the same website and relate to the same subject matter, the motivation to combine them is apparent.

13. With regard to claim 1, Seattle FilmWorks discloses a process for making at least one digital image available to a user on a server after processing of the image, the process comprising: receiving a code sent by a user via a telephone call or a mobile

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Internet session which identifies at least one image which is to be processed (Roll number identifies roll of pictures) ("Login", Lines 5-12), defining an address on the server by integrating a number identifying the customer ("PhotoMail Instruction", Page 2, Lines 3-6); and storing the at least one image at the defined address on the server ("PhotoMail Instruction", Page 2, Lines 3-6). Seattle FilmWorks fails to specifically disclose recovering a number which uniquely identifies a terminal by means of which the user sent the code; associating the code identifying said at least one image with the number identifying the terminal; and defining an address on the server by integrating the number identifying the terminal.

However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to use a unique identifier for terminal because Applicant has not disclosed that the unique terminal identifier provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well using either the unique terminal identifier or the unique customer identifier taught by Seattle FilmWorks (Customer number) ("Login" Lines 5-12) because both types of identifiers performs the same function of assigning the images to a particular customer equally well.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Seattle FilmWorks to obtain the invention as specified in claim 1.

14. With regard to claim 3, Seattle FilmWorks further discloses that the code identifying said at least one image is a number associated with a support on which said at least one image to be processed is found (Roll Number) ("Login", Lines 5-12).

15. With regard to claim 4, Seattle FilmWorks further discloses that said at least one image to be processed is a digital image (digital files can be sent in for processing) ("FAQ", Page 3, Lines 8-12).

16. With regard to claims 5-7, while the system disclosed by Seattle Filmworks shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that the code identifying the at least one image to be processed is a number of an APS cartridge, a number of an envelope into which is inserted a film support, or a number identifying the place where the envelope was handed in by the user.

However, the choice of one of these sources for the code to identify the at least one image to be processed would merely be a design choice for one of ordinary skill in the art. These different code sources all uniquely identify the at least one image, ensuring that images are not confused with one another.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use any unique identifier for the at least one image to be processed so that images are not confused with one another.

17. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seattle FilmWorks in view of Afifi et al.

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18. With regard to claims 2 and 8, while the system disclosed by Seattle Filmworks shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that the receiving step comprises automatically recovering, during the call or the mobile Internet session, the user's telephone number or automatically identifying the place where the telephone call or mobile Internet session is coming from.

Afifi et al. teaches the use of a telephone number to identify a system user. A telephone number is a simple means for identifying a customer since each customer typically has a different telephone number, especially in the case of a mobile phone. Identifying the place (number) where the call originated from and using the customer's telephone number to identify them provides a simple identification means that does not require the customer to remember additional information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine what number the telephone call or mobile Internet session originates from and using this information to identify the customer, since it provides an easy to remember means for the customer to be identified.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 703-305-8878. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ANS 9/16/2004



FRANTZ B. JEAN
PRIMARY EXAMINER